

REMARKS

I. Status of Application

By the present Amendment, claims 2 and 23 have been amended. Claims 1-2, 5, 8-9, 17-19 and 22-34 are all the claims pending in the application.

II. Claim Rejections Under 35 U.S.C. §103

Claims 1, 2, 5, 8-9, 17-19 and 22-34 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6, 517,180 to Tullis et al. (hereinafter “Tullis”), in view of U.S. Patent No. 6,527,360 to Otsuki et al. (hereinafter “Otsuki”), and further in view of U.S. Patent No. 6,215,557 to Owens (hereinafter “Owens”). Claims 2 and 23 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Tullis, in view of Otsuki, and further in view of U.S. Patent No. 7,198,349 to Endo et al. (hereinafter “Endo”). Applicant respectfully traverses all of these rejections.

As an initial matter, Applicant notes that Endo is only available as a reference as of its filing date under 35 U.S.C. §102(e) (June 30, 2004). Further, Seiko Epson Corporation is the assignee of Endo by virtue of an assignment from all of the inventors thereof executed on November 4, 2004 and recorded by the USPTO on November 24, 2004. Seiko Epson Corporation is also the assignee of the present application by virtue of an assignment from all of the inventors thereof executed on November 4, 2005 and recorded by the USPTO on January 9, 2006. Therefore, Applicant submits that both Endo and the present invention were, at the time the invention of the present application was made, owned or subject to an obligation of assignment to Seiko Epson Corporation. Accordingly, Endo is not available as prior art under

§103(c) and all the rejections based on Endo should properly be withdrawn for *at least* these reasons.

Nevertheless, without conceding to the merits of the Examiner's rejections, independent claim 2 has been amended, as set forth above, to recite (among other things):

...a plurality of the colored block patterns
are formed on said medium lined up in a straight
line in said moving direction and leaving no
space between the colored block patterns adjacent
to one another...

Support for these amendments is provided by *at least* FIGS. 18A, 18B and 19 of the original specification in which a multitude of block patterns BL are formed with no spacing between adjacent patterns. No new matter has been added.

The cited references fail to teach or suggest the above features. In contrast to claim 2, Owens teaches, as clearly shown in FIG. 3, forming the test images 33 while leaving a space between adjacent patterns. Therefore, Owens does not teach, and cannot possibly suggest, that a plurality of the colored block patterns are formed leaving no space between the colored block patterns adjacent to one another, as recited in claim 2.

Amended claim 2 also recites:

...a plurality of the colored block patterns...
said plurality of the colored block patterns
constituting a group of tested colored block
patterns to be subjected to testing...

said group of tested colored block patterns
is surrounded by a non-tested pattern that is not
subjected to testing...

Support for these amendments is provided by *at least* FIG. 19 and paragraph [0157] of the original specification, which describes that the "non-tested region 73 is formed so as to

enclose the tested region 72.” Forming a non-tested pattern surrounding the group of tested patterns, for example, a serves to prevent erroneous detection when the downstream-side optical sensor 55 detects the block patterns BL within the tested region 72 (paragraph [0157]. No new matter has been added.

None of the available prior art references teaches or suggests such a claimed configuration. Therefore, claim 2 is patentable over the cited references for *at least* these reasons.

In addition, amended claim 2 recites:

...a plurality of the colorless block patterns are formed... leaving a space between the colorless block patterns adjacent to one another...

...said second sensor detects... a degree of smearing of said colored liquid at a position where said colorless block pattern is to be formed...

The above amendments are fully supported by the original specification. No new matter has been added.

As recited in claim 2, although the colored block patterns are formed without leaving any space therebetween, a plurality of the colorless block patterns are formed leaving a space between the colorless block patterns adjacent to one another and, further, said second sensor detects a degree of smearing of said colored liquid at a position where said colorless block pattern is to be formed. Indeed, since, according to illustrative embodiments, ejection of a colorless nozzle is tested based on smearing of the colored liquid on each colorless block pattern, it is necessary to leave a space between the colorless block patterns in order to provide room for the colored liquid to smear.

None of the cited references disclose, or even remotely suggest, such a configuration. For instance, while U.S. Patent No. 5,898,443 to Yoshino¹ may arguably teach making a coloring agent in an ink insoluble, Yoshino is silent regarding making a colored ink smear. Moreover, Yoshino does not have to leave a space between adjacent patterns because the apparatus therein does not employ smearing.

Accordingly, for *at least* the reasons discussed above, Applicant submits that independent claim 2 is patentable over the cited references.

Moreover, in view of the similarity between the requirements of amended independent claim 23, and the requirements discussed above with respect to claim 2, Applicant respectfully submits that arguments analogous to the foregoing arguments as to the patentability of independent claim 2 demonstrate the patentability of claim 23. As such, it is respectfully submitted that claim 23 is patentably distinguishable over the cited references *at least* for reasons analogous to those presented above.

Further, Applicant submits that the dependent claims 1, 5, 8, 9, 17-19, 22, and 24-34 are allowable *at least* by virtue of their dependency.

Thus, the allowance of these claims is respectfully solicited of the Examiner.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

¹ Cited in the Office Action of June 18, 2008.

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Respectfully submitted,

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